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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/682,657

10/09/2003

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J6860(C)

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EXAMINER

SOROUGH, LAYLA

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/682,657	<b>Applicant(s)</b> POLONKA, JACK	
	<b>Examiner</b> LAYLA SOROUGH	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The response filed December 20, 2008 presents remarks and arguments submitted to the office action mailed September 30, 2008 is acknowledged.

Applicant's arguments over the 35 U.S.C. 102(b) rejection of claims 1-13 and 15-22 over Grollier et al. (US 5000937) as evidenced by Andrean et al. (5205837) is not persuasive. Therefore, the rejection is maintained for the reasons of record.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claim 14 over Grollier et al. (US 500937) and Andrean et al. (5205837), as discussed in claims 1-13 and 15-22 above is not persuasive. Therefore, the rejection is maintained for the reasons of record.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 1-3, 5-9, 11-13, 15-17, 19 and 20 over Nagatani et al. (US 2002/0176833) is not persuasive. Therefore, the rejection is maintained for the reasons of record.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 4, 10 and 18 over Nagatani et al. (US 2002/0176833) in view of Dreher (US 2003/0157041) is not persuasive. Therefore, the rejection is maintained for the reasons of record.

Applicant's arguments over the 35 U.S.C. 103(a) rejection of claims 13 and 14 over Nagatani et al. (US 2002/0176833) in view of Tan et al. (US 6,511,672) is not persuasive. Therefore, the rejection is maintained for the reasons of record.

The rejections are modified below to address the newly added claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13 and 15-24 rejected under 35 U.S.C. 102(b) as being anticipated by Grollier et al. (US 5000937) as evidenced by Andrean et al. (5205837).

Grollier et al. discloses transparent cosmetic composition for protecting the human epidermis against infrared radiation, which comprises, in a cosmetically acceptable vehicle, an effective amount of at least one substance that reflects infrared radiation, dispersable in said vehicle, possessing a reflectance (R) of infrared radiation equal to at least 45%, and of which a 2% strength dispersion in vaseline possesses an optical transmission in the visible of at least 85%, selected from the group consisting of diatomite, hollow glass microspheres of particle size less than 100 microns, bismuth oxychloride of particle size less than 75 microns, and zirconium powder-covered ceramic microparticles of particle size less than 8 microns (claim 1). The transparent cosmetic contains 1 to 3% by weight, based on the total weight of the composition, of at least one infrared-reflecting agent (claim 6), in the form of a suspension or dispersion in solvents or fats, in the form of an emulsion or in the form of an ointment, a gel, a solid stick, or an aerosol. The form of a water-in-oil emulsion comprises in addition to the infrared-reflecting agent, fatty alcohols, fatty acid esters, fatty acids, lanolin, natural or synthetic oils or waxes, and emulsifiers, in the presence of water (claims 10 and 12).

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The bismuth oxychloride have an average particle size 6 to 15 microns, sold by the company MALLINCKRODT under the name "PEARL GLO."

Andrean et al. teaches "PEARL GLO" are lamellar (thin plate-like) in structure.

Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present, hence meeting the limitations of claims 1, 16, and 23-24.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grollier et al. (US 500937) and Andrean et al. (5205837), as discussed in claims 1-13 and 15-24 above.

Grollier et al. (US 500937) and Andrean et al. are as discussed above.

Although, Grollier et al. does not teach the specific benefit agents of claim 14, the reference does teach linoleates for the purpose of promoting oil retention; salicylates useful as UV screening agents capable of being used in the transparent cosmetic composition according to the invention.

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to incorporate the specific benefit agents.

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One having ordinary skill in the art would have been motivated to do this to obtain the desired oil retention and UV screening properties of the composition as suggested by Grollier et al. Hence, a skilled artisan would have reasonable expectation of successfully producing a composition with similar efficacy and results.

Claims 1-3, 5-9, 11-13, 15-17, 19-20 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatani et al. (US 2002/0176833).

Nagatani et al. teach pigmented and non-pigmented cosmetic compositions containing 0.1-30% by wt. of hollow plate metal oxide particles A (e.g. zirconium oxide) having an average particle diameter of 5-12  $\mu\text{m}$  and 0.01-99% by wt. of inorganic particles B (e.g. aluminum oxide, barium sulfate or boron nitride), having platy structure and a refractive index (RI) of 1.6 to 1.8 and a total transmittance of at least 85%. See [0016]-[0018], [0025], [0026], [0031], [0034], Examples. The compositions of Nagatani et al. have "an excellent feeling of transparency". See Abstract; Examples. The compositions contain other conventional cosmetic ingredients such as oil substances, antioxidants, moisturizers, surfactants, perfumes, etc. See [0049]-[0051]; Examples.

Nagatani et al. does not explicitly teach the claimed opacity of the composition of less than about 20%, or a smooth crystal facet surface.

However, the compositions of Nagatani et al. have "an excellent feeling of transparency", "brightness," "natural finish," and are fine and smooth. See above. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to determine an optimal or workable opacity and smoothness of the composition by routine experimentation. One having ordinary skill in

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the art would have been motivated to do this to obtain the desired transparency, natural finish, and smooth feel of the composition as suggested by Nagatani et al. With respect to Claims 6 and 20, the reference does not explicitly teach the claimed particle thickness. However, determination of optimal or workable particle thickness by routine experimentation is obvious absent showing of criticality of the claimed parameter. One having ordinary skill in the art would have been motivated to do this to obtain the desired transparency and natural finish of the composition.

Claims 4, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatani et al. (US 2002/0176833) as applied to claims 1-3, 5-9, 11-13, 15-17, 19-20 and 23-24 above in view of Dreher (US 2003/0157041), of record.

Nagatani et al. applied as above.

Nagatani et al. do not teach bismuth oxychloride of Claims 4 and 18.

However, Dreher teaches using plate-like bismuth oxychloride particles having an average particle size of 3-20  $\mu\text{m}$  for the same purpose as boron nitride and barium sulfate powders of Nagatani et al. See [0010]. The compositions of Dreher provide soft, translucent glowing effect to the skin, which is due to the presence of the inorganic particles. See [0010].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Nagatani et al. such that to use bismuth oxychloride particles instead of boron nitride or barium sulfate particles. One having ordinary skill in the art would have a reasonable expectation of obtaining the same cosmetic emollient effect as set forth in the Nagatani et al. reference because

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these particles are used interchangeably for the same art-recognized purpose as suggested by Dreher. Selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

With respect to Claim 10, Nagatani et al. do not explicitly teach the particles suspended in a polar solvent prior to incorporation in the composition as claimed herein.

However, Dreher teaches making optical make-up compositions for minimizing skin flaws by first suspending bismuth oxychloride and other inorganic particles in butylene glycol (polar solvent), then adding the mixture to the water (polar solvent) and pigments mixture; and then mixing the resulting water phase (with pigment particles suspended in it) with the oily phase. See Example 1 @ pp. 2-3. The compositions of Dreher, when applied to the skin, give a high feeling of transparency, hide imperfections and give natural feeling and appearance of the skin. See [0004].

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Nagatani et al. such that to suspend their platelet particles in polar solvents before incorporating the particle into the composition. One having ordinary skill in the art would have been motivated to do this to obtain imperfection-concealing compositions having natural skin feel and appearance as suggested by Dreher.



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Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagatani et al. (US 2002/0176833) as applied to claims 1-3, 5-9, 11-13, 15-17, 19-20 and 23-24 above in view of Tan et al. (US 6,511,672), of record.

Nagatani et al. applied as above.

While teaching skin benefit agents, Nagatani et al. do not explicitly teach the specific benefit agents of the instant claim.

However, Tan et al. teach skin benefit agents such as vitamins (e.g. vitamin A or retinol, vitamins C and E), skin lightening agents, alpha- or beta-hydroxy acids, etc. in skin imperfection-concealing compositions. See col. 7, lines 32-64. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the compositions of Nagatani et al. such that to employ retinol or other skin benefit agents of Tan et al. for their art-recognized purpose. One having ordinary skill in the art would have a reasonable expectation of beneficial results such as an antioxidant effect.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

Applicant's arguments filed December 30, 2008 have been fully considered but are not persuasive.

Applicant argues bismuth oxychloride is available in many forms and often used in cosmetics in the powdery form. Components in the powdery form are known to be opacifiers and therefore prohibit the radiant effect of the claimed invention. Examiners

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contention is that the cosmetic of Grollier which comprises the bismuth oxychloride is transparent. Hence, the argument that the bismuth oxychloride may act as an opacifier is not persuasive. With respect to the argument that the particles of Grollier are not single-crystals, the Examiner states the prior art teaches the same platy particles, bismuth oxychloride having the same size, and in the same amount as claimed. The crystal particles are identical hence meet the limitation single crystal and smooth-crystal facet surface. Moreover, CAS (attached document) teaches the same bismuth oxychloride have a Refractive Index of 2.15. The smoothness of the bismuth oxychloride is inherent to the particles because the light scattering and reflection by the surface is identical to that claimed.

Applicant's argument over claim 14 rejection depends on the validity of the previous arguments which were not found persuasive.

Applicant argues the Nagatani et al. reference teaches a cosmetic having metal oxide plate powder with a hollow structure. The Examiner states the prior art teaches both a hollow powder as well as component (B). "The component (B) used in the present invention is inorganic powder high in both diffuse transmittance and total transmittance, and it is preferred from the viewpoints of said effect and transparency that the diffuse transmittance be at least 70% and the total transmittance be at least 85% when forming a thin film having a thickness of 25  $\mu\text{m}$  at a powder concentration of 20% by weight. The refractive index of the powder is 1.6 to 1.8. However, any inorganic powder having a refractive index outside this range may also be used by coating it with

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an organic polymer or the like to adjust the refractive index thereof. The component (B) has no hollow structure (para [0027]).”

Applicant argues that the inorganic powder having a refractive index of 1.6-1.8 is used in a concentration of 20% by weight in Nagatani et al. Examiner respectfully reiterates the prior art teaches when forming a thin film having a thickness of 25 um a powder concentration of 20% by weight is used. Hence, applicant's argument is not persuasive. Additionally the general disclosure teaches 0.01-99% by wt. of inorganic particles B.

Applicant's argument over claims 13 and 14 rejection depends on the validity of the previous arguments which were not found persuasive.

The arguments are not persuasive and the rejection is made **FINAL**.

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617